Hovsepian v. Apple, Inc. Doc. 69

HENNIGAN, BENNETT & DORMAN LLP
RODERICK G. DORMAN (SBN 96908)
ALAN P. BLOCK (SBN 143783)
KEVIN SHENKMAN (SBN 223315)
601 South Figueroa Street, Suite 3300
Los Angeles, California 90017
Phone: (213) 694-1200
Fax: (213) 694-1234
dormanr@hbdlawyers.com
blocka@hbdlawyers.com
shenkmank@hbdlawyers.com

Attorneys for Plaintiff
ACACIA MEDIA TECHNOLOGIES CORPORATION

UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION	Case No. 05 CV 01114 JW MDL No. 1665 **PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S OPPOSITION TO DEFENDANTS' MOTION FOR RECONSIDERATION OF THE COURT'S CONSTRUCTION OF THE TERM "REMOTE LOCATIONS"** **DATE:** September 8-9, 2005 **TIME:** 9:00 a.m. **CTRM:** Hon. James Ware

Dockets.Justia.com

TABLE OF CONTENTS

(Page)

I. INTRODUCTION 1

II. THE INTRINSIC PATENT DOCUMENTS DO NOT SUPPORT DEFENDANTS' CONSTRUCTION OF "REMOTE LOCATIONS" AS MEANING "A LOCATION REMOTE FROM THE REQUESTING SITE" 2

A. Nothing in the Claims of the '992 Patent Limits the Meaning of "Remote Locations" to "a Location Remote from the Requesting Site" 2

1. In the Context of Claims 1 and 41, the Term "Remote Locations" Refers to Locations Remote from the Transmission System 3

2. In the Context of Claims 19 and 47, the Term "Remote Locations" Also Refers to Locations Remote from the Transmission System 4

B. Nothing in the Specification of the '992 Patent Limits the Meaning of "Remote Locations" to "a Location Remote from the Requesting Site" 5

1. The '992 Patent Specification Describes Three Embodiments of the Invention Which Do Not Require a User Request 6

2. The '992 Patent Specification Describes Four Additional Embodiments of the Invention Which Include a User Request 7

3. The Patentees Did Not Make a Clear Disavowal of Claim Scope in the Specification Which Would Limit "Remote Locations" to "a Location Remote from the Requesting Site"........... 9

C. Nothing in the Prosecution History of the '992 Patent Limits the Meaning of "Remote Locations" to "a Location Remote from the Requesting Site" 12

D. Nothing in the Prosecution History of the Related '720 Patent Limits the Meaning of "Remote Locations" to "a Location Remote from the Requesting Site" 16

1. The Patentees' Statements during the '720 Patent Prosecution Are Not Binding on the Patentees 16

2. The Patentees Never Stated During the '702 Patent Prosecution that the Invention Required that the Information be Transmitted to a Location Remote from the Requesting Site. 18

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
LOS ANGELES, CALIFORNIA

TABLE OF CONTENTS (Cont'd)

(Page)

3. The Patentees' Amendment of Original Claim 33 of the '720 Patent Only Serves to Confirm the Court's Construction of "Remote Locations" 20

4. The *Microsoft* Case is Distinguished by its Facts 23

III. CONCLUSION 25

TABLE OF AUTHORITIES

(Page)

Cases

Abtox, Inc. v. Exitron Corp.,
122 F.3d 1019 (Fed. Cir. 1997) 2, 18

ACTV, Inc. v. Walt Disney Co.,
346 F.3d 1082 (Fed. Cir. 2003) 3

Aquatex Industries, Inc. v. Techniche Solutions, __ F.3d __,
2005 U.S. App. LEXIS 17588 (Fed. Cir. 2005) 12

Athletic Alternatives, Inc. v. Prince Mfg., Inc.,
73 F.3d 1573 (Fed. Cir. 1996) 12

Chimie v. PPG Indus., Inc.,
402 F.3d 1371 (Fed. Cir. 2005) 12

Cordis Corp. v. Medtronic AVE, Inc.,
339 F.3d 1352 (Fed. Cir. 2003) 12

DeMarini Sports, Inc. v. Worth, Inc.,
239 F.3d 1314 (Fed. Cir. 2001) 12

Desper Products, Inc. v. QSound Labs., Inc.,
157 F.3d 1325, 1340 (Fed. Cir. 1998) 16, 22

Digital Biometrics v. Identix, Inc.,
149 F.3d 1335 (Fed. Cir. 1998) 16

E-Pass Techs., Inc. v. 3 Com Corp.,
343 F.3d 1364 (Fed. Cir. 2003) 11

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.,
535 U.S. 722 (2002) 21

Gemstar-TV Guide International, Inc. v. International Trade Commission,
383 F.3d 1352 (Fed. Cir. 2004) 11

Georgia-Pacific Corp. v. United States Gypsum Co.,
195 F.3d 1322 (Fed. Cir. 1999) 17

Goodyear Dental Vulcanite Co. v. Davis,
102 U.S. 222 (1880) 21

Hockerson-Halberstadt, Inc. v. Converse, Inc.,
183 F.3d 1369 (Fed. Cir. 1999) 3

TABLE OF AUTHORITIES (Cont'd)

(Page)

Hoganas AB v. Dresser Industries, Inc., 9 F.3d 948 (Fed. Cir. 1993) 4

Honeywell Inc. v. Victor Co. of Japan, Ltd., 298 F.3d 1317 (Fed. Cir. 2002) 10

Liebel-Flarsheim Co. v. Mallinckrodt, Inc., 358 F.3d 898 (Fed. Cir. 2004) 4, 5, 10, 11

Mark I Mktg. Corp. v. R.R. Donnelly & Sons Co., 66 F.3d 285, 291 (Fed. Cir. 1995) 13

Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S.Ct. 1384 (1996) 5

Microsoft Corp. v. Multi-Tech Systems, Inc., 357 F.3d 1340 (Fed. Cir. 2004) 17, 23, 24

Northern Telecom Ltd. v. Samsung Electronics Company, 215 F.3d 1281 (Fed. Cir. 2000) 12

Northrop Grumman Corp. v. Intel Corp., 325 F.3d 1346 (Fed. Cir. 2003) 10

NTP, Inc. v. Research in Motion, Ltd., __ F.3d __, 2005 U.S. App. LEXIS 15920 (Fed. Cir. 2005) 9, 12, 14, 17

Pall Corp. v. PTI Techs. Inc., 259 F.3d 1383 (Fed. Cir. 2001) 12

Phillips v. AWH Corp., __ F.3d at __, 2005 U.S. App. LEXIS 13954 (Fed. Cir. 2005) ..... passim

Read v. Portec, Inc., 970 F.2d 816 (Fed. Cir. 1992) 12, 15

Renishaw PLC v. Marposs Societa' Per Azioni, 158 F.3d 1243 (Fed. Cir. 1998) 2

Resonate Inc. v. Alteon Websystems, Inc., 338 F.3d 1360 (Fed. Cir. 2003) 10

Rexnord Corp. v. Laitram Corp., 274 F.3d 1336 (Fed. Cir. 2001) 12

Schwing GMbH v. Putzmeister Aktiengesellschaft, 305 F.3d 1318 (Fed. Cir. 1992) 12

TABLE OF AUTHORITIES (Cont'd)

(Page)

Seachange International, Inc. v. C-Cor, Inc., 413 F.3d 1361, 2005 U.S. App. LEXIS 12893 (Fed. Cir. 2005) 13

Serrano v. Telular Corp., 111 F.3d 1578 (Fed. Cir. 1997) 12

Southwall Tech., Inc. v. Cardinal IG Co., 54 F.3d 1573 (Fed. Cir. 1995) 16

SRI Int'l v. Matsushita Elec. Corp. of America, 775 F.2d 1107 (Fed. Cir. 1985) 11

Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313 (Fed. Cir. 2002) 6, 11, 12

Vanguard Prods. Corp. v. Parker Hannifin Corp., 234 F.3d 1370 (Fed. Cir. 2000) 12

ZMI Corp. v. Cardiac Resuscitator Corp., 844 F.2d 1576 (Fed. Cir. 1988) 12

Hennigan, Bennett & Dorman LLP
Lawyers
Los Angeles, California

I. INTRODUCTION

Plaintiff Acacia Media Technologies Corporation ("Acacia") hereby opposes defendants'[1] motion for reconsideration of the court's construction of the term "remote locations."

There is no legal basis for modifying the Court's construction of "remote locations" as "positions or sites distant in space from the transmission system." This is how the term is understood from the claims, the patent specification, and the prosecution history, both of the '992 patent and of the later-filed '720 patent. The Court's construction is correct and should be affirmed.

The Federal Circuit teaches that the language of the claim frames and ultimately resolves all issues of claim construction. In this case, it is evident from the claims of the '992 patent themselves that the remote locations are remote from the transmission system. Claim 41 of the '992 patent does not include a user, a user request, or a requesting site, but does include reference to transmission system transmitting information to remote locations. The Court only has to examine the specification and prosecution history to determine whether the patentees made a clear disavowal of claim scope.

As shown by Acacia in this opposition, the patentees made no clear disavowal of claim scope which would limit the meaning of remote locations to "a location remote from the requesting site." Nowhere do the patentees limit their invention such that it can only transmit information to a location remote from the requesting site; the patentees described and supported multiple embodiments of their invention in the patent specification – some of which do not require any user request, some of which specifically permit the information to be transmitted directly to the requesting site, and some of which permit the information to be transmitted to a site remote from the requesting site.

Defendants ignore the Federal Circuit's teaching. Defendants start their claim construction with the statements made by the patentees almost six years after the '992 patent issued during the prosecution of the '720 patent evidence and contend that these statements evidence a clear

[1] The term "defendants," as used herein refers to all of the defendants who have joined in this motion, as set forth in the motion at page 1, n 1.

disavowal by the patentees of the meaning of the term “remote locations” in the ‘992 patent. Defendants, however, ignore the fact that the patentees responded to the examiner’s rejection over prior art by amending the pending claim to add limitations to make clear that the claim includes a user and a user request, to make clear that the user is positioned at an accessing location, and to make clear that the information is transmitted to a remote location selected by the user. The fact that the patentees added these limitations to the claim in an amendment is an acknowledgement that these limitations were not in the claim prior to the amendment. There was no clear disavowal of claim scope caused by the patentees’ statements in the ‘720 patent.

Accordingly, the language of the claims controls and the term “remote locations” is construed as “positions or sites distant in space from the transmission system.” The Court should therefore deny defendants’ motion for reconsideration.

II. THE INTRINSIC PATENT DOCUMENTS DO NOT SUPPORT DEFENDANTS’ CONSTRUCTION OF “REMOTE LOCATIONS” AS MEANING “A LOCATION REMOTE FROM THE REQUESTING SITE”

A. Nothing in the Claims of the ‘992 Patent Limits the Meaning of “Remote Locations” to “a Location Remote from the Requesting Site”

Defendants’ seek to construe the term “remote locations” in the claims of the ‘992 patent by referring almost exclusively to the patentees’ statements made during prosecution of the later-filed ‘720 patent. This is not the way to construe a patent claim. “The language of the claim frames and ultimately resolves all issues of claim interpretation.” *Abtox, Inc. v. Exitron Corp.*, 122 F.3d 1019, 1023 (Fed. Cir. 1997); *Renishaw PLC v. Marposs Societa' Per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998) (“The claims define the scope of the right to exclude; the claim construction inquiry, therefore, begins and ends in all cases with the actual words of the claim.”) The words of a claim are generally given their ordinary meaning to a person of ordinary skill in the art at the time of the invention. *Phillips v. AWH Corp.*, __ F.3d at __, 2005 U.S. App. LEXIS 13954, at *22 (Fed. Cir. 2005).

In this case, the term “remote locations” is found in independent claims 1, 19, 41, and 47 of the ‘992 patent and is used in a similar manner in each of these claims. From the context of each of these claims, "remote locations" are locations remote from the transmission system to which the information is transmitted.

1. In the Context of Claims 1 and 41, the Term "Remote Locations" Refers to Locations Remote from the Transmission System

Claims 1 and 41 are similar to each other. Claim 41, for instance, is "[a] method of transmitting information to *remote locations*, performed by a transmission system, comprising the steps . . . of: . . . sending at least a portion of the file to one of the *remote locations*." ('992 patent, 24:54 – 25:5; Exhibit 1[2]; emphasis added).

According to claim 41, the method of transmitting information to remote locations is performed by a transmission system. The only point of reference in claim 41 for the remote locations is the transmission system, and therefore, in the context of claim 41, the remote locations must be remote from the transmission system.[3] Because there is nothing in claim 41 which would indicate that the remote locations are remote from something other than the transmission system, the Court correctly construed "remote locations" the way that it did. (Markman Order, at 4:16-22; Exhibit 2).

Defendants contend that claim 41 of the '992 patent does not *expressly* identify any place from which a location is said to be remote and that it does not follow from the claim that the place from which a location is said to be remote is the transmission system. (Motion, at 18:15 – 19:5). Defendants are wrong; the claim expressly identifies the transmission system and, for the claim to make sense, the remote locations must be remote from the transmission system.

Defendants ignore the claim construction rule that "the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed terms appears, but in the context of the entire patent, including the specification." *Phillips*, __ F.3d at __, 2005 U.S. App. LEXIS 13954, at *24. Figures 1a, 1b, 1c, 1d, 1e, 1f, 1g, 2b, and 6 illustrate that information is transmitted from the transmission system to remote locations, as shown by arrows (the arrows show the transmission of the information from the transmission system). In each case, the arrows are drawn from the transmission system, which would indicate to persons skilled in the art that the remote locations are locations remote from the transmission system. None of these Figures show a user request or a requesting site and none of the Figures show that the information is transmitted to "a location remote from the requesting site."

---

[2] All exhibits referred to herein are attached to the accompanying Declaration of Alan P. Block filed in support of Acacia's Opposition to defendants' motion re "remote locations."

[3] *See*, *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003) ("the context of the surrounding words of the claim also must be considered in determining the ordinary and customary meaning of those terms."); *Phillips*, __ F.3d at __, 2005 U.S. App. LEXIS 13954, at *27 ("To begin with, the context in which a term is used in the asserted claim can be highly instructive."); *Hockerson-Halberstadt, Inc. v. Converse, Inc.*, 183 F.3d 1369, 1374 (Fed. Cir. 1999) ("[p]roper claim construction . . . demands interpretation of the entire claim in context, not a single element in isolation.")

By seeking to have the Court interpret "remote locations" as "a location remote from the requesting site," defendants seek to *add* the limitations to claim 41 of a user, a user request, and a requesting site. There is no mention of a user, a user request, or a requesting site in claim 41 and these limitations cannot be found in the term "remote locations." This indicates that the patentees did not intend for claim 41 to include these limitations. *Liebel-Flarsheim Co. v. Mallinckrodt, Inc.*, 358 F.3d 898, 909 (Fed. Cir. 2004) ("The omission of reference to a pressure jacket in many of the claims of the applications that matured into the '669 and '261 patents is a strong indication that the applicants intended those claims to reach injectors that did not use pressure jackets."); *See also, Hoganas AB v. Dresser Industries, Inc.*, 9 F.3d 948, 950 (Fed. Cir. 1993) ("It is improper for a court to add 'extraneous' limitations to a claim, that is, limitations added wholly apart from any need to interpret what the patentee meant by particular words or phrases in the claim.")

Therefore the term "remote locations," as used in claim 41, means locations remote from the transmission system; "remote locations" *cannot* mean "a location remote from the requesting site."

2. In the Context of Claims 19 and 47, the Term "Remote Locations" Also Refers to Locations Remote from the Transmission System

Claims 19 and 47 are similar to each other. Claim 19, for instance, is "[a] distribution method responsive to requests from a user identifying items in a transmission system containing information to be sent from the transmission system to *receiving systems at* ***remote locations***, the method comprising the steps of: . . . sending a request, by the user to the transmission system, for at least a part of the stored information *to be transmitted to the one of the receiving systems at one of* *the* ***remote location*** *[sic] selected by the user. . .*" ('992 patent, 22:26-39; Exhibit 1; emphasis added). Claim 19 further specifies that the information is sent to, received by, stored in, and played back at "the selected *remote location*." ('992 patent, 22:40-50; Exhibit 1; emphasis added).

Claim 19 requires *additional* language to modify "remote locations."[4] These additional limitations are *not* subsumed by the term "remote locations." *See Phillips*, __ F.3d at __, 2005 U.S. App. LEXIS at 13954, at *27 ("To take a simple example, the claim in this case refers to 'steel baffles,' which strongly implies that the term 'baffles' does not inherently mean objects of steel.'"); *Liebel-Flarsheim*, 358 F.3d at 910 ("The juxtaposition of independent claims lacking any reference to a pressure jacket with dependent claims that add a pressure jacket limitation provides strong support for Liebel's argument that the independent claims were not intended to require the presence of a pressure jacket.") This is exactly what the Court found. (Markman Order, at 4:23 – 5:2; Exhibit 2).

B. Nothing in the Specification of the '992 Patent Limits the Meaning of "Remote Locations" to "a Location Remote from the Requesting Site"

It is also necessary for the Court to consider the specification of the '992 patent when construing the claim term "remote locations." *Phillips*, __ F.3d at __, 2005 U.S. App. LEXIS at 13954, at *29, *quoting*, *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S.Ct. 1384 (1996) ("The claims 'must be read in view of the specification, of which they are part.'") "[T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." *Phillips*, __ F.3d at __, 2005 U.S. App. LEXIS at 13954, at *29, *quoting*, *Vitronics* , 90 F.3d at 1582.

---

[4] Even with these additional limitations, nothing in claim 19 *requires* that the information be transmitted to "a location remote from the requesting site." This is because the claim states that the user request is for "information to be transmitted to the one of the receiving systems at systems at one of the remote location [sic] selected by the user." The claim does *not* preclude a user from selecting the *same* location as the location from where the request is made; i.e., in claim 19, the information may be received at the requesting site. Thus, it would be improper to construe "remote locations" as "a location remote from the requesting site," because this is not even a limitation of claim 19.

The Court may not limit the claims to a particular embodiment disclosed in the specification or read limitations from the specification into the claims. *Phillips*, __ F.3d at __, 2005 U.S. App. LEXIS at 13954, at *55 ("[a]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments."); *Specialty Composites*, 845 F.2d at 987 ("Where a specification does not require a limitation, that limitation should not be read from the specification into the claims.")

The written description may only restrict the scope of the claims if "the patentee demonstrated an intent to deviate from the ordinary and accustomed meaning of a claim term by redefining the term or by characterizing the invention in the intrinsic record using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed. Cir. 2002).

In its Markman Order, the Court considered the patent specification and properly held that there was no disavowal of claim scope which would limit the meaning of "remote locations." (Markman Order, at 5:13-22; Exhibit 2).

1. The '992 Patent Specification Describes Three Embodiments of the Invention Which Do Not Require a User Request

The '992 patent specification describes three embodiments of the invention which do not require a user request. (*See, e.g.*, '720 patent, 2:25-48; 4:52-63; and 15:61-65; Exhibit 1). The operator of the transmission system, for example, could determine the remote location(s) to which content is to be transmitted. As these embodiments do not include a user, a user request, or a requesting site, the term "remote locations," when used to describe these embodiments, *cannot* mean "a location remote from the requesting site."

In two of these embodiments of the invention, in which no user request is required, the patentees used the term "remote locations" to refer to locations remote from the transmission system. ('702 patent, 2:25-48 and 15:61-65; Exhibit 1).[5],[6]

---

[5] At 2:25-48, the patentees described an embodiment without requiring a user request and without requiring that the information be sent to "a location remote from the requesting site": "the transmission and receiving system for providing information to *remote locations* comprises . . . means . . . for sending at least a portion of a specific file to a specific one of the *remote locations*." ('992 patent, 2:25-48; Exhibit 1; emphasis added).

In the other embodiment in which no user request is required, the transmission system broadcasts the information over an airwave communication channel to a plurality of users at remote locations.[7] ('702 patent, 4:52-63; Exhibit 1). There is no user request or requesting site in this embodiment and thus the term "remote locations" cannot be used to refer to "a location remote from the requesting site" with respect to this embodiment.

2. The '992 Patent Specification Describes Four Additional Embodiments of the Invention Which Include a User Request

The '992 patent specification describes four embodiments of the invention which include a user request. (*See* '992 patent, 2:49-61; 5:10-21; 14:64-67; 18:46-45; Exhibit 1). However, nothing in the specification *requires* that, in these embodiments, the information is only transmitted to a location remote from the requesting site. In each embodiment, the information may be transmitted to the requesting site.

In two of these embodiments in which a user makes a request, the patentees used the term "remote locations" to describe locations that are remote from the transmission system, but did not require that the information only be transmitted to "a location remote from the requesting site." ('702 patent, 2:49-61 and 18:46-45; Exhibit 1). In each case, the requested information may be transmitted to the requesting site.[8],[9]

---

[6] At 15:61-65, the patentees described another embodiment without requiring a user request and without requiring that the information be sent to "a location remote from the requesting site": "[t]he transmission system 100 of the present invention preferably further includes transmitter means 122, coupled to the compressed data library 118, for sending at least a portion of the specific file to at least one *remote location*." ('992 patent, 15:61-65; Exhibit 1; emphasis added).

[7] At 4:52-63, the patentees describe an embodiment where the transmission of the information is broadcast to a plurality of users (i.e., remote locations): "Fig. 1g shows a high level block diagram of the transmission and receiving system of the present invention including transmission system 100 distributing to a reception system 200, which then preferably transmits requested material over airwave communication channels 200d, to a plurality of users." ('992 patent, 4:52-63; *See also,* 17:12-24; Figure 1g; Exhibit 1).

[8] At 2:49-61, the patentees described an embodiment which included a user request, but did not state that the transmission be sent to "a location remote from the requesting site;" the information may be sent to the requesting site: "The present invention further comprises a distribution method responsive to requests identifying information to be sent from a transmission system to a *remote location*, the method comprising the steps of storing audio and video information in a compressed data form; requesting transmission, by a user, of at least a part of the stored compressed information to the *remote location*; sending at least a portion of the stored compressed information to the *remote location*; receiving the sent information at the *remote location*; buffering the processed information

In another embodiment in which a user may make a request, the patentees expressly state that the user may make the request from the *same* reception system to which the information is sent; i.e., the requested information is sent to the requesting site. Adoption of defendants' proposed construction would exclude this disclosed embodiment from the scope of the patent. In this embodiment, the patentees described the reception system as including "specialized interfaces built into the reception system 200 for the user." ('992 patent, 14:64-67; Exhibit 1). This interface is shown in Figure 6 with reference number 207 (the user/computer interface) being a component of the reception system 200. ('992 patent, Figure 6; Exhibit 1). With the user/computer interface 207, the user can make a request for the transmission of information. ('992 patent, 15:3-22; Exhibit 1). The requested information would be received by the transceiver 201 of the reception system 200. ('992 patent, Figure 6; Exhibit 1). Thus, according to this embodiment of the invention, a user may use the reception system 200 to both request information and to receive that information, meaning that the requested information is sent to the requesting site.

In another embodiment in which a user may make a request, the patentees state that the user *may*, but is not required to, make a request for an item from a location remote from the location of the reception system to which the item will be sent. ('992 patent, 5:10-21; Exhibit 1). This embodiment is specifically limited to "direct connection" configurations, which are illustrated only in Figures 1e and 1f.[10] The patentees' use of the permissive term "*may*" necessarily means that the

---

at the *remote location*; and playing back the buffered information in real time at a time requested by the user." ('992 patent, 2:49-61; Exhibit 1; emphasis added).

[9] At 18:46-45, the the patentees described another embodiment which included a user request, but did not state that the transmission be sent to "a location remote from the requesting site;" the information may be sent to the requesting site: "The distribution method is preferably responsive to requests identifying information to be sent from the transmission system 100 to *remote locations*." ('992 patent, 18:46-50; *See also*, Figure 7; Exhibit 1; emphasis added).

[10] At 5:10-21, the patentees described direct connection configurations: "*In direct connection configurations, such as reception systems 200 shown in FIGS. 1e and 1f*, the user preferably selects the reception system 200 to which the requested material is sent, and optionally selects the time playback of the requested material as desired. Accordingly, the user *may* remotely access the transmission system 100 from a location different than the location of reception system 200 where the material will be sent and/or played back. Thus, for example, a user *may* preferably call transmission system 100 from work and have a movie sent to their house to be played back after dinner or at any later time of their choosing." ('992 patent, 5:10-21; Exhibit 1; emphasis added).

patentees contemplated that the user may also access the transmission system from the same location where the information will be sent and/or played back.[11] Had the patentees *required* that the transmission be to "a location remote from the requesting site," they would *not* have used the word "may," and instead would have used a different word, such as "must."

3. The Patentees Did Not Make a Clear Disavowal of Claim Scope in the Specification Which Would Limit "Remote Locations" to "a Location Remote from the Requesting Site"

Defendants contend that the specification of the '992 patent contains a clear disavowal of claim scope requiring the term "remote locations" to mean "a location remote from the requesting site,"[12] because the specification describes *the* invention as enabling a user to request and receive information at different respective locations, and to choose among several locations to receive the requested information. (Motion, at 19:24 – 20:18). Defendants rely on two statements from the "Background of the Invention" section of the specification as support for this contention, while ignoring the remainder of the specification (especially, the Summary of the Invention and Description of the Preferred Embodiments sections).

First, defendants rely on the patentees' description of the prior art *Walter* reference in the Background section. ('992 patent, 1:18-29; Exhibit 1). Here, the patentees are describing a prior art patent; they are not describing their own invention. When discussing the *Walter* reference, the patentees do *not* distinguish their invention from *Walter*, do *not* state that "remote locations" means "a location remote from the requesting site," and do *not* state that their invention is limited to a single embodiment wherein the information is only transmitted to "a location remote from the requesting site." This statement is *not* a clear disavowal of claim scope which would limit the term "remote locations" to "a location remote from the requesting site."

---

[11] In one recent Federal Circuit case, the court held that the use of the term "basically" in a patent specification suggests the existence of other embodiments. *See, NTP, Inc. v. Research in Motion, Ltd.*, __ F.3d __, 2005 U.S. App. LEXIS 15920, *29 (Fed. Cir. 2005) ("Campana described prior 'electronic mail services' as 'basically a wire line-to-wire line, point-to-point type of communications.' . . . The use of the term 'basically' suggests that an electronic mail system may include other types of connections, including wireless connections.")

[12] This is the *second* interpretation of the specification of the '992 patent. Previously, the adult entertainment internet defendants contended during the initial Markman proceedings that the alleged disavowal in the specification meant that remote locations means "more than one location selected by the user."

Defendants further rely on a statement in the Background section regarding one of the "objects" of the invention: "It is a further object of the present invention to provide a picture and sound transmission system which allows the user to remotely select audio/video material from any location that has either telephone service or a computer." ('992 patent, 1:62-66; Exhibit 1). This statement is describing *user requests*, not the location to where the information is sent, and therefore this cannot support defendants' contention that information must be transmitted to "a location remote from the requesting site."

The next "object" described in the "Background" section states that the information is transmitted to *any* location selected by the user: "A still further object of the present invention is to provide a picture and sound transmission system wherein the selected audio/video material is sent over any one of several existing communication channels in a fraction of real time *to any location chosen by the user that has a specified receiver*." ('992 patent, 1:67 – 2:4; Exhibit 1; emphasis added). This "object" of the invention does not *require* that the information be transmitted to a location remote from the requesting site; rather it permits the information to be sent to *any* location chosen by the user, including the requesting site.[13],[14]

---

[13] The fact that the '992 patent contains multiple "objects" of the invention means that the claims are not limited to structures capable of achieving all of the objectives. *Liebel-Flarsheim,* 358 F.3d at 908, *citing*, *Resonate Inc. v. Alteon Websystems, Inc*., 338 F.3d 1360, 1367 (Fed. Cir. 2003); *Northrop Grumman Corp. v. Intel Corp.*, 325 F.3d 1346, 1355 (Fed. Cir. 2003); *Honeywell Inc. v. Victor Co. of Japan, Ltd.*, 298 F.3d 1317, 1325-26 (Fed. Cir. 2002) ("[t]he fact that a patent asserts that an invention achieves several objectives does not require that each of the claims be construed as limited to structures that are capable of achieving all of the objectives.")

[14] Defendants themselves recognize that there is no requirement that, in all embodiments of the invention, information must be transmitted from the transmission system to "a location remote from the requesting site." Defendants state that "[b]ut in *all* instances – whether selectable or not – a 'remote location' means a site that ***may*** be remote from where the user is requesting the information." (Motion, at 19:21-23; emphasis added). Defendants also state that "the specification 'makes clear that the invention *does not include' limiting* a user to ordering and receiving information at the *same* location." (Motion, at 21:1-2; emphasis added). Defendants' statements contradict their proposed construction. Defendants seek to construe "remote locations" as *requiring* that the transmission be to "a location remote from the requesting site." Defendants' statements, however, indicate that transmission to "a location remote from the requesting site" is not a requirement of invention, but is only a *capability* of the invention. The Court's construction of "remote locations" is consistent with defendants' statements, because locations remote from the

The fact that the patentees described the invention as including multiple embodiments and features demonstrates that the patentees made no clear disavowal of claim scope in the patent specification.[15] The *GoLight* case is on point. *GoLight*, 355 F.3d at 1331. In *GoLight*, the court found that the fact that the patent specification described multiple features of the invention meant that there was no clear definition or disavowal of claim scope in the written description:

> We see no clear definition or disavowal of claim scope in the written description of the *'989 patent* that would limit claim 11 to horizontal rotation through 360 degrees. While it is true that the patentees describe their invention as having the ability to rotate through 360 degrees, this particular advantage is but one feature of the invented search light. The written description describes other significant features as well, such as the use of a particular wireless remote control and differing mechanisms for attaching the search light to the roof of a vehicle.

GoLight, 355 F.3d at 1331.[16]

Thus, defendants' contention that "remote locations" must be limited to "a location remote from the requesting site" would contradict the specification of the '992 patent. Defendants'

---

transmission system may be remote from the requesting site or may be the requesting site.

[15] Even though the patentees described multiple features to their invention, the patentees were not required to include within each of their claims all of these features. *See*, *GoLight*, 355 F.3d at 1331, *citing*, *E-Pass Techs., Inc. v. 3 Com Corp.*, 343 F.3d 1364, 1370 (Fed. Cir. 2003) ("An invention may possess a number of advantages or purposes, and there is no requirement that every claim directed to that invention be limited to encompass all of them.") and *SRI Int'l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) ("If everything in the specification were required to be read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims.")

[16] *See also*, *Liebel-Flarsheim*, 358 F.3d at 908 ("Although all the embodiments described in the common specification of the '669 and '261 patents include a pressure jacket, the written description does not contain a clear disavowal of embodiments lacking a pressure jacket. . . . Although that language can reasonably be understood as constituting a general description of the invention, the quoted passage does not suggest that a pressure jacket is an essential component of the invention, nor is there any language in that passage, or elsewhere in the specification, that disclaims the use of the invention in the absence of a pressure jacket."); *Teleflex*, 299 F.3d at 1328 ("The specification describes only one embodiment of the claimed 'clip (28),' but in the circumstances of this case the record is devoid of 'clear statements of scope' limiting the term appearing in claim 1 to having "a single pair of legs.' Absent such clear statements of scope, we are constrained to follow the language of the claims, rather than that of the written description."); *Gemstar-TV Guide International, Inc. v. International Trade Commission*, 383 F.3d 1352, 1366 (Fed. Cir. 2004), *quoting*, *Teleflex*, 299 F.3d at 1327 ("In the context of the disclosure of the preferred embodiment of the '204 patent, the statement that 'innovative cursor 32 . . . is required,' is not the 'use [of] words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.'")

construction must therefore be rejected. *See, NTP v. Research in Motion, Ltd.*, __ F.3d at __, 2005 U.S. App. LEXIS 15920, at *30 (Fed. Cir. 2005) ("Accordingly, because RIM's argument that the term 'electronic mail system' cannot include wireless connections contradicts the text and figures of the written description, it must be rejected.")

C. Nothing in the Prosecution History of the '992 Patent Limits the Meaning of "Remote Locations" to "a Location Remote from the Requesting Site"

The Court should also consider the '992 patent's prosecution history. The purpose of consulting the prosecution history in construing a claim is to "exclude any interpretation that was disclaimed during prosecution." *Chimie v. PPG Indus., Inc.*, 402 F.3d 1371, 1384 (Fed. Cir. 2005), *quoting*, *ZMI Corp. v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 1580 (Fed. Cir. 1988). The Federal Circuit, however, cautions courts that, because the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, the prosecution history "often lacks the clarity of the specification and thus is less useful for claim construction purposes." *Phillips*, __ F.3d at __, 2005 U.S. App. LEXIS at 13954, at *36, *citing*, *Inverness*, 309 F.3d at 1380-82 and *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1580 (Fed. Cir. 1996).[17]

"The prosecution history may demonstrate that the patentee intended to deviate from a term's ordinary meaning, i.e., if it shows the applicant characterized the invention using words or expressions of manifest exclusion or restriction during the administrative proceedings before the Patent and Trademark Office." *Teleflex*, 299 F.3d at 1326. A disclaimer of claim scope requires "clear and unmistakable statements of disavowal." *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1358 (Fed. Cir. 2003).

---

[17] The Federal Circuit will not apply the doctrine of prosecution disclaimer where the alleged disavowal of claim scope is ambiguous. *See*, *Aquatex Industries, Inc. v. Techniche Solutions*, __ F.3d __, 2005 U.S. App. LEXIS 17588, at *16-17 (Fed. Cir. 2005); *Cordis Corp.*, 339 F.3d at 1359;.*Northern Telecom Ltd. v. Samsung Electronics Company*, 215 F.3d 1281, 1293-95 (Fed. Cir. 2000); *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1347 (Fed. Cir. 2001); *Pall Corp. v. PTI Techs. Inc.*, 259 F.3d 1383, 1393-94 (Fed. Cir. 2001); *DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1326-27 (Fed. Cir. 2001); *Vanguard Prods. Corp. v. Parker Hannifin Corp.*, 234 F.3d 1370, 1372 (Fed. Cir. 2000); *Serrano v. Telular Corp.*, 111 F.3d 1578, 1584 (Fed. Cir. 1997); *Schwing GMbH v. Putzmeister Aktiengesellschaft*, 305 F.3d 1318, 1325 (Fed. Cir. 1992); and *Read v. Portec, Inc.*, 970 F.2d 816, 824 (Fed. Cir. 1992).

The patentees filed the application for the '992 patent on January 7, 1991, and included claims 1-32. Independent claims 1, 18, and 22 of the original application correspond to claims 1, 19, and 25 of the '992 patent.

On June 17, 1991, the patentees filed a Petition to Make Special pursuant to M.P.E.P. § 708.02 (VIII). In the Petition, the patentees described transmitting information to "remote locations" in original claim 1[18] as transmitting the information to the *user* (not to "a location remote from the requesting site"):

> Claims 1-17 are directed to a transmission system for providing information to *remote locations*. . . . Transmitter means, for example transmitter format means 119 and transmitter 122, transmit the requested program *to the user*."[19]

(Petition to Make Special, at pages 3-4; Exhibit 3).

This statement demonstrates that the term "remote locations" refers to locations remote from the transmission system, because the users are remote from the transmission system. The patentees did not disavow claim coverage."[20], [21]

---

[18] Original claim 1 is the same as claim 1 of the '992 patent with respect to its use of the term "remote locations:" "1. A transmission system for providing information to remote locations, the transmission system comprising, . . . transmitter means, . . . , for sending at least a portion of the file to one of the remote locations." (Exhibit 4).

[19] The patentees also used the term "remote locations" in the Petition to Make Special when describing other references (not mentioned by defendants), but did not state that "remote locations" refers to "a location remote from the requesting site." (*See*, Petition to Make Special, at pages 6-7 [discussing *Lang*, U.S. Patent No. 4,963,995]; pages 10-11 [discussing *Lumelsky*, U.S. Patent No. 4,949,169]; pages 11-12 [discussing *Fenwick*, U.S. Patent No. 4,947,244]; pages 12-13 [discussing *Eggers*, U.S. Patent No. 4,920,432]; page 15 [discussing *Southworth*, U.S. Patent No. 4,400,717, using the term "remote user locations"]).

[20] Similarly, the patentees described claims 18-21 (corresponding to claims 19-22 of the '992) as including a "user request of the stored information for transmission to a selected remote location (step 415)." The patentees did not state that the selected remote must be "a location remote from the requesting site." Again, the patentees did not disavow claim coverage or indicate any intent to define "remote locations" as "a location remote from the requesting site."

[21] In their motion, defendants ignore these statements from the prosecution history. The Court, however, must consider the entire prosecution history, *not* just the portion selected by defendants. *Seachange International, Inc. v. C-Cor, Inc.*, 413 F.3d 1361, 2005 U.S. App. LEXIS 12893, *24 (Fed. Cir. 2005) ("[W]e examine the entire prosecution history, which includes amendments to claims and all arguments to overcome and distinguish references."); *Mark I Mktg. Corp. v. R.R. Donnelly & Sons Co.*, 66 F.3d 285, 291 (Fed. Cir. 1995) ("The prosecution history must be examined as a whole in determining whether estoppel applies.")

In the Petition to Make Special, the patentees discussed thirty-seven references. In their motion, the defendants only address one of these thirty-seven references, *Walter*, U.S. Patent No. 4,506,387, and contend that the patentees' statements regarding *Walter* requires that the term "remote locations" means "a location remote from the requesting site." (Motion, at 22:12 – 23:1). In the Petition to Make Special, the patentees discussed the *Walter* reference in general and then described how each of original claims 1, 18, and 22 is distinguished from *Walter*. When *generally* discussing *Walter*, the patentees stated, among other things, that:

> Although the system [of *Walter*] affords the viewer some control over accessing the material, it requires that a location designated by the viewer be wired with a dedicated cable. The *Walter* system further requires that the viewer be at that location for both ordering and viewing the audio/video material.

(Petition to Make Special, at page 9; Exhibit 3).

This statement is *not* a clear and unmistakable disclaimer of any claim scope to the '992 patent.[22] The patentees do not state that their invention or any claim lacks these features of *Walter*, do not state that "remote locations" means "a location remote from the requesting site," and do not state that their invention is limited to a single embodiment wherein the information is only transmitted to "a location remote from the requesting site."[23] The patentees argued the specific distinctions over *Walter* separately and with respect to each independent claim, but did not distinguish any claim based on the location of the viewer when ordering or viewing the video.[24] The patentees did not make a clear disavowal of claim scope.

---

[22] *See, NTP*, __ F.3d at __, 2005 U.S. App. LEXIS 15920, at *31 ("Our review of the prosecution history reveals no disclaimers or disavowals limiting an "electronic mail system" to a wireline only system. . . . Contrary to RIM's assertions, however, Campana did not accept a narrow definition of 'electronic mail system' or disclaim subject matter, so as to limit the term 'electronic mail system' to a wireline only system. Instead, Campana expressly stated that information sent between the originating and destination processors located in 'an electronic mail system' in his invention could be accomplished either through the RF transmission network or a wireline.")

[23] Defendants interpret the patentees' statements as requiring only that "a user must be physically present at the *same* location for both requesting and receiving information." This is an incorrect interpretation. Defendants ignore the requirement that the location where the user is located must be a designated site having a dedicated cable. This is evident from the words "that location" in the statement: "The *Walter* system further requires that the viewer be at *that location* for both ordering and viewing the audio/video material." In other words, *because Walter* requires a location designated by the viewer which is wired with a dedicated cable, the viewer must be at the location which is wired with the dedicated cable for both ordering and viewing the audio/video material.

In its Markman Order, the Court considered this same statement from the Petition to Make Special regarding *Walter* and others, and correctly found that there was no disavowment of claim scope, because the prior art was overcome for more than one reason.[25] (*See,* Markman Order, at 6:3 – 7:2; Exhibit 2). The Court relied on the fact that "the applicants distinguished the present invention in that none of the references provided for the storing of the information at the receiving system so that the information may be played back at a later time selected by the user." (Markman Order, at 6:23-28; Exhibit 2). The applicants made other distinctions over *Walter* in addition to the storing of information at the receiving system, including the designated site having a dedicated cable, the user being located at this designated site, and the lack of the "preprocessing elements" (i.e., the identification means, the conversion means, the ordering means, and the compressed data means). (*See,* Petition to Make Special, at 9-10; Exhibit 3).

In their motion, defendants contend that the Court's analysis was incorrect, because "arguments that distinguish application claims from the prior art on multiple grounds often create separate and independent restrictions on claim scope." (Motion, at 23:4-7). Defendants cite

---

[24] For instance, the patentees distinguished original claim 1 from *Walter* on the grounds that *Walter* does not teach the preprocessing elements (i.e., the identification means, the conversion means, the ordering means, and the compressed data means) required in claim 1, but did not mention the user's location as a distinguishing feature: "Therefore, *Walter* does not teach or suggest the preprocessing elements required in independent claim 1. Additionally, there is no teaching or suggestion in *Walter* that only a portion of an item stored in the library modules 22-34 can be sent to a subscriber, as further recited in independent claim 1." (Petition to Make Special, at page 10; Exhibit 3). Similarly, the patentees distinguished *Walter* from original claims 18 and 22 on the grounds that *Walter* does not teach a receiver which buffers compressed information and does not teach a receiver which includes a storage means; the patentees did not distinguish *Walter* based on the user's location when making a request: "Accordingly, *Walter* does not teach or suggest buffering the received information, which is compressed, at the remote location, as recited in independent claim 18, or a receiver including storage means, coupled to receiver format conversion means, for storing compressed formatted data, as set forth in independent claim 22." (Petition to Make Special, at page 10; Exhibit 3).

[25] The Court's finding is legally correct. *See, The Read Corporation v. Portec, Inc.*, 970 F.2d 816, 824 (Fed. Cir. 1992) ("Read pointed out differences not only respecting the wheels, including that they were not collapsible and were in a different location (on the side, not on the end) but also marked differences in other parts of the structure. Thus, any estoppel created by Portec's argument encompasses all of these combined distinctions of Deister and not an estoppel respecting each of the individual differences, e.g., that any device with non-movable wheels cannot infringe.")

Seachange, 413 F.3d 1361, 2005 U.S. App. LEXIS 12893, at *27. The *Seachange* case did not address whether arguments that distinguish application claims from the prior art on multiple grounds create separate and independent restrictions. In *Seachange*, the patentees argued to the Examiner the patentability of a group of claims by referring specifically to only one of the group of the claims. *Seachange*, 413 F.3d at 1361, 2005 U.S. App. LEXIS 12893, at *25-26. When addressing this exemplary claim, the patentees contended that the claim was distinguished over the prior art references for two reasons – "point-to-point" and "redundant storage." *Id.* Later, in litigation, the patentees attempted to argue that one of the claims of the group (not the exemplary claim) did not include the point-to-point limitation, but the court held that both distinctions applied to all of the claims in the group, and therefore this claim was limited with respect to both "point-to-point" and "redundant storage." *Id.* at *27-33. *Seachange* therefore applied the *combination* of the limitations; it said nothing about these limitations being separate from one another.[26]

The patentees therefore did not make any clear and unmistakable statement of disavowal during the prosecution of the '992 patent which would cause the term "remote locations" to be interpreted as "a location remote from the requesting site."

D. Nothing in the Prosecution History of the Related '720 Patent Limits the Meaning of "Remote Locations" to "a Location Remote from the Requesting Site"

1. The Patentees' Statements during the '720 Patent Prosecution Are Not Binding on the Patentees

The patentees filed the '720 patent on April 10, 1996, almost four years *after* the '992 patent had issued, on July 21, 1992. The '720 patent is related to the '992 patent, because it is a continuation patent which claims priority from the '992 patent. In their motion, defendants contend that the patentees' statements made during the prosecution of the '720 patent application in 1997

[26] Defendants also cite *Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1573 (Fed. Cir. 1995), *Desper Products, Inc. v. QSound Labs., Inc.*, 157 F.3d 1325, 1340 (Fed. Cir. 1998), and *Digital Biometrics v. Identix, Inc.*, 149 F.3d 1335, 1347 (Fed. Cir. 1998). In each case, the court found estoppels based on clear, unmistakable arguments made to distinguish claims over the prior art. Here, there was no disavowal of claim scope. The facts of these cases are therefore distinguished from those of this case.

and 1998 create a disclaimer of claim scope which affects the construction of the term "remote locations" in the '992 patent.

The adult entertainment internet defendants raised the issue of the '720 patent prosecution history during the initial Markman proceedings. In its Markman Order, the Court stated that "[d]uring claim construction of the '992 patent that issued in 1992, it would be improper for the Court to consider a comment made during prosecution of a related patent (the '720 patent) regarding an amendment to a claim made in 1998 to overcome 1993 prior art." (Markman Order, at 7:16-20; Exhibit 2). The Court cited *Microsoft Corp. v. Multi-Tech Systems, Inc.*, 357 F.3d 1340 (Fed. Cir. 2004) and *Georgia-Pacific Corp. v. United States Gypsum Co.*, 195 F.3d 1322 (Fed. Cir. 1999).

In their Motion, defendants contend that the Court erred by not considering the patentees' statements from the '720 patent prosecution history. Subsequent to the issuance of the Court's Markman Order, the Federal Circuit clarified its *Microsoft* decision. In *NTP*, __ F.3d __, 2005 U.S. App. LEXIS 15920, at *19, the Federal Circuit stated that *Microsoft* held that "statements made in prosecution of one patent are relevant to the scope of all sibling patents."

Closer examination of *Microsoft* and *Georgia-Pacific* show, however, that a patentees' statement in a later-filed, related patent application *cannot* create an estoppel or bind the patentee with respect to claim terms used in an earlier-filed patent. In *Microsoft*, the court acknowledged that the patent examiner could not have relied on the statements made in the later-filed patent application when examining the earlier-filed patent. *Microsoft*, 357 F.3d at 1350.

The court then clarified the holding in *Georgia-Pacific*.[27] The court stated that, in *Georgia-Pacific*, it "rejected the argument that the patentee was bound, or estopped, by a statement made in connection with a later application on which the examiner of the first application could not have relied." *Microsoft*, 357 F.3d at 1350. The court went on to say, however, that it did not suggest that such a statement would be irrelevant and therefore statements made by the patentee in the prosecution of a related application as to the scope of the invention would be relevant to claim construction. *Id.* Thus, as defendants even acknowledge, the statements in the ‘720 patent prosecution history do not bind the patentees with respect to the construction of “remote locations” in the ‘992 patent; the statements are merely evidence to be considered with all other evidence relevant to claim construction. (*See*, Motion, at 15:3-5).

---

[27] In *Georgia-Pacific*, the court held that "for Georgia-Pacific to be bound by the statement made to the PTO in connection with a later prosecution of a different patent, the statement would have to be one that the examiner relied upon in allowing the claims in the patent at issue." *Georgia-Pacific*, 195 F.3d at 1333.

In this case, other evidence, such as the language of the claims and the disclosures of the specification, should be given greater weight than after-the-fact statements from the ‘720 patent discussing a claim and prior art that was not part of the ‘992 patent. *See, e.g.*, *Abtox*, 122 F.3d at 1023 (“The language of the claim frames and ultimately resolves all issues of claim interpretation.”)

2. The Patentees Never Stated During the ‘702 Patent Prosecution that the Invention Required that the Information be Transmitted to a Location Remote from the Requesting Site.

Defendants contend that the patentees’ statements regarding original claim 33 of the ‘720 patent application demonstrate that the patentees understood the term “remote locations” to mean “a location remote from the requesting site.” (Motion, at 5:4 – 9:21). Defendants, however, ignore the patentee’s claim amendment. This amendment demonstrates that the patentees conceded that the term “remote locations” does not mean “a location remote from the requesting site.”

Original claim 33 of the ’720 patent application was similar to claim 1 of the ‘992 patent, however, unlike claim 1 of the ‘992 patent, claim 33 claimed a plurality of library means and eliminated the ordering means and compression means. (Exhibit 5). Like claim 1 of the ‘992 patent, claim 33 stated that the transmission system provides information to remote locations, which, in the context of claim 33, refers to locations remote from the transmission system. Like claim 1 of the ‘992 patent, claim 33 made no mention of a user, a user request, or a requesting site. The term “remote locations” in claim 33 therefore could not mean “a location remote from the requesting site.”

On July 24, 1997, the Examiner rejected original claims 33 and 34 over *Wilson*, U.S. Patent No. 5,195,092, stating, among other things, that *Wilson* shows a “transmission system for providing information to be transmitted to remote locations.” (Exhibit 6). On November 21, 1997, the patentees responded to the Examiner’s rejection and argued that claim 33 was distinguished from *Wilson*:

> *Wilson et al.* teaches a system significantly different from the present invention. For example, *Wilson et al.* requires that the shopper be connected to the system resources by telephone for the duration of the transaction. This limits both telephone use by the subscriber as well as availability of system resources to other subscribers.[28] Furthermore, in *Wilson et al.* the subscriber is required to be physically present at the location to which information is transmitted.
>
> In contrast, the present invention provides a flexible system in which a user can remotely access information. That is, the user can request transmission of information to a site remote from the requesting site. Additionally, with the present invention the user does not have to be connected by telephone when information is transmitted from the library to the selected remote location. This frees up system resources for use by others and makes the system much more convenient to use than that disclosed in *Wilson et al.*

(November 21, 1997 Response, at 2; Exhibit 7).

This is not a clear and unmistakable statement of disavowal by the patentees; the patentees do *not* state that the invention described in the specification is limited to embodiments in which the information is only sent to a location remote from the requesting site and do *not* state that the term "remote locations" of claim 33 is limited to "a location remote from the requesting site."[29]

Further, the patentees used only *permissive* words when describing their invention: "*can* remotely access information," "*can* request transmission to a site remote from the requesting site," and "*does not have to be* connected by telephone when information is transmitted from the library to the selected remote location"; the patentees did not use *limiting* words, such as "must" or "only."[30]

---

[28] In their Motion, defendants have replaced the two sentences regarding the use of the telephone with an ellipse. (*See*, Motion, at 7:20-22).

[29] Defendants contend that this statement means that the patentees argued that the invention permits the user to request to request transmission of information to a site remote from the requesting site. (Motion, at 7:13-17). This is not what the patentees said. Similar to their discussion regarding *Walter*, the patentees stated that *because* the subscriber is required to be connected to the system by telephone for the duration of the transaction, the user must be physically present at the location to which the information is transmitted.

[30] Defendants agree that the patentees' statements do not *require* the user to request the transmission of information to a site remote from the requesting site, rather, they merely "*permit*" it: "Applicants Yurt and Browne disagreed, arguing that Wilson is 'significantly different' from 'the present invention' because Wilson requires the subscriber to be physically present at the location to which information is transmitted and that, by contrast, 'the present invention' *permits* the user to request the transmission of information to a site *remote from the requesting site*:" (Motion, at 7:13-17; emphasis added).

This is *consistent* with the specification of the '992 patent, which describes embodiments in which the user *can* remotely access information (remote from the transmission system) – either from the same location to where the information will be sent *or* from a location remote from the location to where the information will be sent – and describes embodiments in which the user can access information without even making a request.

On February 10, 1998, the Examiner responded by stating that the features on which the patentees rely to distinguish from *Wilson* are not recited in the claims and the Examiner will not read these limitations from the specification into the claims. (February 10, 1998 Office Action at 4, Exhibit 8; emphasis supplied). The Examiner stated that the features on which the applicant relies – the user being capable of remotely accessing information, the user being capable of requesting information to a site remote from the requesting site, and the user not having to be connected by a telephone when information is transmitted from the library to the selected remote location – means that the Examiner did not interpret the term "remote locations" in claim 33 of the pending application as including any of these limitations. The Examiner believed that to interpret original claim 33 as suggested by the patentees, would improperly import limitations from the specification into the claim.

The Examiner's comments regarding the patentees' construction improperly importing limitations from the specification into the claim should apply with equal force to defendants' proposed construction. If the Examiner would not allow this construction of "remote locations," then the Court should also not allow this construction.

3. The Patentees' Amendment of Original Claim 33 of the '720 Patent Only Serves to Confirm the Court's Construction of "Remote Locations"

In response to the Examiner's rejection of original claim 33, on August 6, 1998, the patentees filed an amendment to original claim 33 to include additional claim language specifying a user and a user request, specifying that the user be positioned at an accessing location, specifying that the information be transmitted to a remote location selected by the user, and specifying that the remote location may be different from the accessing location:

33. (Amended) A transmission system responsive to input from a user positioned at an accessing location for [providing] transmitting information [to be transmitted to remote locations,] to a remote location selected by the user, the transmission system comprising:

* * *

transmitter means, coupled to the conversion means, for transmission of the formatted data to [one of the remote locations] the remote location selected by the user, wherein the remote location *may* be different from the accessing location.

(August 6, 1998 Response to Office Action at 1-2; Exhibit 9; emphasis added).

The patentees' amendment of original claim 33 of the '720 patent to add these limitations *estops* the patentees from arguing that the term "remote locations" includes any of these limitations. As the Supreme Court in *Festo* established, "[e]stoppel arises when an amendment is made to secure the patent and the amendment narrows the patent's scope." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 736, 740 (2002) ("A patentee's decision to narrow his claims through amendment may be presumed to be a general disclaimer of the territory between the original claim and the amended claim.")

By amending original claim 33 to add these limitations, the patentees disclaimed any interpretation of "remote locations" which would include any of the limitations which the patentees added to the claim to overcome the prior art rejection.[31] *See, Festo*, 535 U.S. at 734 ("A rejection indicates that the patent examiner does not believe the original claim could be patented. While the patentee has the right to appeal, his decision to forgo an appeal and submit an amended claim is taken as a concession that the invention as patented does not reach as far as the original claim."), *citing, Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 228 (1880) ("In view of [the amendment] there can be no doubt of what [the patentee] understood he had patented, and that both he and the commissioner regarded the patent to be for a manufacture made exclusively of vulcanites by the detailed process.")

---

[31] Further, by adding these limitations to original claim 33, the patentees also indicated that the term "remote locations," by itself, did not include these limitations. *See Phillips*, __ F.3d at __, 2005 U.S. App. LEXIS at 13954, at *27 ("To take a simple example, the claim in this case refers to 'steel baffles,' which strongly implies that the term 'baffles' does not inherently mean objects of steel.'")

In their motion, defendants consciously ignore the fact that the patentees amended original claim 33, and instead state that are relying solely on the applicants' statements. (*See*, Motion, at 14, n 7). The Court, however, must consider the entire prosecution history, *not* just the portion selected by defendants,and therefore the Court must consider the patentees' amendment. *Seachange*, 413 F.3d 1361, 2005 U.S. App. LEXIS 12893, *24; *Mark I Mktg.*, 66 F.3d at 291.[32]

The patentees' statement accompanying the amendment actually *confirms* that the amendment was necessary in order for original claim 33 to include the added limitations: "Applicants have amended independent claim 33 to clarify that the remote location to which the information is transmitted is different from the accessing location at which the user is positioned when making the request."[33] (August 6, 1998 Response to Office Action, at 6: Exhibit 9).

Defendants contend that this statement means that the patentees "argued that this amendment was completely *unnecessary* and *redundant* because, in their view, the mere recitation of the term 'remote locations,' *by itself*, already meant a location that 'is different from the accessing location at which the user is positioned when making the request.'" (Motion, at 8:20-23; emphasis supplied). Defendants are wrong. In this statement, the patentees were stating that it was the *amendment* which *clarified* the claim to include these limitations: "Applicants have *amended* claim 33 to *clarify*. . ."[34]

---

[32] Defendants do contend, however, that "the fact that application claim 33 was amended further after these arguments were made is also irrelevant." (Motion, at 16:17-19). Defendants cite *Desper*, 157 F.3d at 1335-36 as support. The court in *Desper* did not hold that the amendments to the claim are *irrelevant* when the prosecuting attorney also makes remarks. In *Desper*, the patentee argued that the court should not consider the attorney's remarks, because they were erroneous and extraneous to the amendment. *Desper*, 157 F.3d at 1335-36. The court held that it could consider both the amendment and the attorney's remarks, because both the amendment and the remarks were made to overcome the prior art rejection. *Id.* at 1336.

[33] On March 3, 1999, the Examiner issued a rejection of amended claim 33 over a reference to *Ballantyne*. (Exhibit 10). On June 7, 1999, the patentees responded to this rejection by canceling amended claim 33 and replacing it with new claim 43, which used the term "user premises" instead of "remote locations." (Exhibit 11). Claim 33 therefore never issued as a patent claim in the '720 patent. Although claim 33 was ultimately canceled from the '720 patent application, claim 1 of the '720 patent also does not require that the transmission of information be to "a location remote from the requesting site." Claim 1 of the '720 patent states that the information is transmitted to "a premises selected by the user, wherein the premises selected by the user is not limited to a predetermined user premises." (Exhibit 12).

Thus, nothing in the prosecution history of the '720 patent evidences a clear and unmistakable statement of disavowal by the patentees to define the term "remote locations" (used in claims 1, 19, 41, and 47 of the '992 patent) as "a location remote from the requesting site." Instead, the patentees' amendment of original claim 33 estops the patentees from arguing that "remote locations" includes this limitation. This confirms the Court's construction of "remote locations" as "positions or sites distant in space from the transmission system."

4. The *Microsoft* Case is Distinguished by its Facts

Defendants discuss the *Microsoft* case at great length in their motion. In *Microsoft*, the court found that the specification only disclosed communications over a telephone network and thus construed these terms as being so limited. *Microsoft*, 357 F.3d at 1348 ("the specification shared by all three patents leads to the 'inescapable conclusion' that the communications between the local and remote sites of the claimed inventions must occur directly over a telephone line.") Further, in *Microsoft*, in response to the examiner's first office action, the patentees provided a "summary of the invention" and explicitly stated that, "in their specification, Applicants disclose a communications system which operates over a standard telephone line." *Microsoft*, 357 F.3d at 1349. This statement in the prosecution history confirmed what was already stated in the specification. *Microsoft*, 357 F.3d at 1349 ("That statement unambiguously reflects Multi-Tech's own understanding of its inventions in the '627, '649, and '532 patents as being limited to the transmission of data packets over a telephone line. We cannot construe the claims to cover subject matter broader than that which the patentee itself regarded as comprising its inventions and represented to the PTO.") The court thus held that the terms "sending," "receiving," and

---

[34] Even after the amendment, claim 33 does not *require* that the information is transmitted to "a location remote from the requesting site." The patentees used the permissive word "*may*" in the claim 33, and thus the patentees did not make it a *requirement* of amended claim 33 that the transmission of information is to "a location remote from the requesting site." This is further evidence that the term "remote locations" cannot mean "a location remote from the requesting site," as defendants contend.

"transmitting" are restricted to communications over a telephone line and thus do not encompass communications over a packet-switched network, such as the Internet. *Microsoft*, 357 F.3d at 1346.

This case differs from *Microsoft*, because neither the specification of the '992 Patent nor the prosecution history of the '720 patent require that "remote locations" be limited to a location remote from the requesting site. In this case, unlike *Microsoft*, the patentees did not limit the description of their invention in the '992 patent specification to systems in which the user may only remotely access the transmission system from a location different than the location of the reception system where the item will be sent. The patentees specifically described multiple embodiments in which the information is transmitted to a remote location, without regard to whether the user is able to select the remote location. (*See,* Section II.B.1. and II.B.2., *supra*). Further, nothing in the specification requires that the system operate only in this manner, and in fact embodiments are disclosed without reference to a user selected functionality.

Unlike the patents in *Microsoft*, the description of the invention in the '992 patent specification is broad and requires Acacia's construction of "remote locations" to capture its breadth—positions or sites distant in space from the position(s) or site(s) of the transmission system. The court in Microsoft limited the construction of the claims to telephone systems, because the specification repeatedly made clear that the patentees described their invention as embodying only communications over a telephone line. *Microsoft*, 357 F.3d at 1348. No such restriction or limitation on the scope of the invention exists in this case.

This case also differs from *Microsoft* with respect to the legal consequences of statements made during patent prosecution. During prosecution of the '627 patent by Multi-Tech, the patentees unequivocally stated that the subject communications system operated over a standard telephone line. In *Microsoft*, the Federal Circuit found that unequivocal statement to confirm the similar statements made in the specification itself concerning the invention. Here, there is no unequivocal statement by the patentees during prosecution describing the invention and every embodiment of it. Unlike *Microsoft*, neither the '992 patent specification or the statements made during prosecution of the '720 patent unequivocally communicated the intent of the patentee to limit his invention to only systems in which the user must remotely access the transmission system from a location different than the location of the reception system where the item will be sent. Indeed, in the '720 patent, the patentees amended their claim to overcome a prior art rejection, thereby estopping the patentees from contending that "remote locations" included these limitations.

III. CONCLUSION

For the foregoing reasons, the Court should reject defendants' request to reconsider the Court's construction of "remote locations" and deny this motion.

DATED: August 25, 2005

HENNIGAN BENNETT & DORMAN LLP

By /s/
Roderick G. Dorman
Alan P. Block
Kevin I. Shenkman
Attorney for Plaintiff
ACACIA MEDIA TECHNOLOGIES CORPORATION

497077\v2